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After Final



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Extension of Time Request



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Reply to Missing Parts/
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PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Scott Clark, et al.

Serial No.: 09/759,103

Group Art Unit: 3622

Filed: January 12, 2001

Examiner: Daniel Lastra

For: Search Engine Providing an Option to
Win the Item Sought

Atty. Doc. No.: 632-001

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APPEAL BRIEF

S I R:

In support of a Notice of Appeal filed September 21, 2007 in the above referenced matter, Applicant respectfully submits this Appeal Brief.

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I. TABLE OF AUTHORITIES

A. CASES CITED

1. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991);
2. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).
3. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) .
4. *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984).
5. *Seasonics v. Aerosonic Corp.*, 38 USPQ 2d 1551, 1554 (1996).
6. *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005 (Fed. Cir. 1983).
7. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

B. UNITED STATES STATUTES CITED

1. 35 United States Code §103

C. PATENTS AND PATENT PUBLICATIONS CITED

1. United States Patent Application Pub. No. 2003/0054888, to Walker, *et al.*
2. United States Patent Application Pub. No. 2003/0016779, to Roll, *et al.*
3. United States Patent No. 6,331,143, to Yoseloff, *et al.*
4. United States Patent No. 5,933,811, to Angles, *et al.*

D. SECONDARY SOURCES CITED

1. File Wrapper for United States Patent Application Serial Number 09/759,013 for “Search Engine Providing an Option to Win the Item Sought” (subject of current appeal).
2. Manual of Patent Examining Procedure (MPEP) §§2143-2143.03.

II. REAL PARTY IN INTEREST

The real party in interest in this appeal is PickaPin.com of Bronx, NY. Scott Clark of New York, New York, Armen Djourian, of New York, New York and Moujan Vahdat of New York, New York are the inventors and have assigned an interest to PickaPin.com in the invention that is currently subject to appeal. The assignment to PickaPin.com is recorded with the United States Patent and Trademark Office at Reel/Frame 019348/0373.

III. RELATED APPEALS AND INTERFERENCES

On September 26, 2005, in response to an Office Action dated June 27, 2005 finally rejecting all of the then-pending claims, Applicant filed a Notice of Appeal and a Request for a Pre-Brief Appeal Conference. On December 13, 2005, a Notice of Panel Decision from Pre-Appeal Brief Review maintained the rejection of claims 1-30. On February 27, 2006, Applicant filed a Request for Continued Examination (RCE) and Amendment. The Office Action dated June 27, 2005, Applicant's Pre-Appeal Brief Request for Review, the Notice of Panel Decision from Pre-Appeal Brief Review are appended in Appendix III.

Applicant is unaware of any other prior appeal, pending appeal, judicial proceeding, or interference proceeding which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this proceeding.

IV. STATUS OF CLAIMS

Claims 1, 10, 15 and 21-22 were last amended in the Response and Amendment dated February 27, 2006. Claims 31-36 were added in the Response and Amendment dated February

27, 2006. Claims 1-36 are pending in the application and stand finally rejected under 35 U.S.C. §103 by the Examiner in the Office Action dated May 21, 2007.

The Amendment dated February 27, 2006 and Final Rejection dated May 21, 2007 are attached in Appendix II.

V. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the Final Office Action dated May 21, 2007. Applicants consider the claims listed in Appendix I to be the claims at issue in this appeal.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

There are eight independent claims in the present application, Claim 1, Claim 10, Claim 15, Claims 21-22, Claim 33 and Claims 35-36. A brief summary of each independent claim is discussed below, with reference being made to the specification of the presently appealed application. A copy of the claims can be found in Appendix I.

Claim 1 provides for a method for providing a game of chance related to a user's acquisition of a selected product. In particular, Claim 1 recites:

1. A method of providing a user with a game of chance, the method comprising the steps of:
receiving electronic signals from a user system representing search
parameters descriptive of a product; (e.g., paragraph [0031], Fig. 2a,
elements 203 and 205)

retrieving at least one product information from at least one database storing
third-party retail vendor product information; (e.g., paragraph [0031], Fig.
2a, element 206)
transmitting electronic signals to the user system representing product information
and associated prices; (e.g., paragraph [0031], Fig. 2a, element 207)
automatically providing the user with an option to play a game to win a selected
product (e.g., paragraph [0031], Fig. 2a, element 208) from said product
information without the user first making any payment or requesting the
option; (e.g., paragraph [0032], Figs. 2a and 2b, element 210)
electronically calculating a probability of winning the selected product by the
user; (e.g., paragraph [0032], Fig. 2b, element 214)
electronically generating a pseudo-random outcome corresponding to the
calculated probability of winning; (e.g., paragraph [0032], Fig. 2b,
element 215) and
in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig.
2b, element 216) purchasing the selected product for the user from the
third-party retail vendor. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 3 provides a method step for providing the results of the pseudo-random outcome
of a game of chance to a user by displaying a user-chosen number with a comparison number.
Claim 3 particularly recites:

3. The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, (e.g., paragraphs [0008, 0055-0058]) such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. (e.g., paragraphs [0008, 0058]).

Claim 6 provides a method step permitting a user to increase their odds of winning a game of chance, and recites:

6. The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation. (e.g., paragraph [0094]).

Claim 10 provides for an alternative embodiment of the present invention where a user is given the option of purchasing the desired product outright, or winning the product through a game of chance. Claim 10 recites:

10. A method of providing a user with a game of chance, the method comprising:
 - receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2b, element 215)
 - retrieving at least one product information from at least one database storing third-party retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product; (e.g., paragraph [0031, 0053], Fig. 2a, element 207)

automatically transmitting electronic signals representing at least a first option for the user to play a game (e.g., paragraph [0031], Fig. 2a, element 208) to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209)

if the user chooses to play the game (e.g., paragraph [0031], Fig. 2a, element 210):

electronically calculating a probability of winning the product by the user; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, element 214) and

in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing the product for the user from the third-party retail vendor; (e.g., paragraph [0032], Fig. 2b, element 218) and

if the user chooses to purchase the product instead of playing the game (e.g., paragraph [0031], Fig. 2a, element 209):

directing the user to a web site which sells the product. (e.g., paragraph [0054]).

Claim 15 provides for an alternative embodiment of the present invention where a response to a user's inquiry regarding a product is predicated on a user provided search parameter. Claim 15 recites:

15. A method of providing a user with a game of chance, the method comprising:
 - receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)
 - retrieving at least one product information from at least one database storing third-party retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)
 - transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter; (e.g., paragraph [0031], Fig. 2a, element 206)
 - automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; (e.g., paragraph [0031], Fig. 2a and 2b, element 210) and
 - if the user chooses to play the game: (e.g., paragraph [0031], Fig. 2a, element 209)
 - electronically calculating a probability of winning said selected one product by the user; (e.g., paragraph [0031], Figs. 2a and 2b, element 210)

electronically generating a pseudo-random outcome corresponding to the
calculated probability of winning; (e.g., paragraph [0032], Fig. 2b,
elements 214 and 215) and
in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig.
2b, element 216) purchasing said selected one product from a
corresponding third-party retail vendor for the user. (e.g., paragraph
[0032], Fig. 2b, element 218).

Claim 21 provides for an alternative search result embodiment. Claim 21 recites:

21. A method of providing a user with a game of chance, the method comprising:
- receiving electronic signals from a user system representing at least one search
parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2a,
elements 203 and 205)
 - searching for products matching said at least one search parameter; (e.g.,
paragraphs [0031, 0035], Fig. 2a, element 206)
 - transmitting electronic signals to the user system representing a plurality of
third-party retail vendors and associated prices charged by each of
said third-party retail vendors for products identified in response to
said at least one search parameter, each of the products identified being
offered for sale on a corresponding web site of each third-party
retail vendor; (e.g., paragraphs [0031, 0053], Fig. 2a, element 207)
 - automatically transmitting electronic signals to the user representing an option to

play a game (e.g., paragraph [0031], Fig. 2a, element 208) to win a selected one of said products without the user first making any payment or requesting the option; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209) and

if the user chooses to play the game (e.g., paragraph [0031], Fig. 2a, element 210):

electronically calculating a probability of winning said selected one product by the user; (e.g., paragraph [0032], Fig. 2b, element 214) electronically generating a pseudo-random outcome having a probability corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215) and

in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing said selected one product from a corresponding third-party retail vendor for the user. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 22 provides for an alternative embodiment of the present invention with another method for allowing a user to play a game of chance to win a desired product. Claim 22 recites:

22. A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service; (e.g., paragraph [0031, 0034], Fig. 2a, element 204)

conducting a search in a database for a third-party retail vendor product or service that satisfies the search query; (e.g., paragraph [0031], Fig. 2a, element 206)

automatically presenting a result of the search to the user, including at least one product or service offered for sale by said third-party retail vendor retrieved from the database, along with an option to play the game; (e.g., paragraph [0031], Fig. 2a, element 207)

enabling the user to select the product or service that he wants to win; (e.g., paragraphs [0031, 0033], Fig. 2a, element 208)

determining the user's chance of winning the selected product or service; (e.g., paragraph [0032], Fig. 2b, element 214)

generating an outcome for each play of the game that corresponds to the user's chance of winning; (e.g., paragraph [0032], Fig. 2b, element 215) and

displaying the outcome of the game to the user. (e.g., paragraph [0032], Fig. 2b, element 217).

Claim 30 provides an embodiment of the present principles where the probability of winning a product or service is increased in response to a user participating in a particular sponsored survey. Claim 30 specifically recites:

30. The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. (e.g., paragraph [0094]).

Claim 33 provides for an alternative embodiment of the present invention wherein the invention is directed to generating traffic through a website. Claim 33 recites:

33. A method for increasing user traffic to a search engine website, comprising:
- receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; (e.g., paragraph [0031], Fig. 2a, elements 204 and 205) and
- transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product (e.g., paragraph [0031], Fig. 2a, element 209) and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (e.g., paragraphs [0031, 0043], Fig. 2a, element 209).

Claim 35 provides for an embodiment of the present invention reciting an alternative method for generating traffic through a website. Claim 35 recites:

35. A method for increasing user traffic to a search website, comprising:
- providing a search webpage containing a search interface for a user to submit a search query for a product; (e.g., paragraphs [0031, 0043-0044], Fig. 2a, elements 204 and 205)
- receiving a search query from a user employing said search webpage; (e.g., paragraph [0031], Fig. 2a, element 204)

searching third party websites by reference to said query; (e.g., paragraph [0031], Fig. 2a, element 206)

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query; (e.g., paragraph [0031], Fig. 2a, element 206)

providing a game of chance in response to a user selection of the link to win the product; (e.g., paragraph [0031], Fig. 2a, element 208) and purchasing the product from the third party for the user response to a favorable outcome in said game; (e.g., paragraph [0032], Fig. 2b, element 218)

transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, (e.g., paragraph [0054]) and a link to win the product; (e.g., paragraph [0031], Fig. 2a, element 210)

providing a game of chance in response to a user selection of the link to win the product; (e.g., paragraph [0031], Fig. 2a, elements 208 and 210) and purchasing the product from the third party for the user in response to a favorable outcome in said game. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 36 provides for an alternative embodiment of the present invention having a product search website apparatus that permits a user to play a game of chance to win a desired product. Claim 36 recites:

36. A product search website executing on a server storing a plurality of web pages, the website comprising:

a search page for a user submitting a query to the server for at least one product;

(e.g., paragraph [0031], Fig. 2a, elements 204 and 205)

a results webpage transmitted to the user, the results page including links to third party

website and a link to a play webpage of the website; (e.g., paragraphs [0031,

0053-0055], Fig. 2a, element 207)

a play webpage providing a game of chance for winning the product corresponding to a

selected play link from the results webpage; (e.g., paragraphs [0031, 0053-0055],

Fig. 2a, element 214) and

a product win webpage to indicate a favorable outcome in said game of chance for said

product. (e.g., paragraphs [0032, 0058], Fig. 9).

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following summaries are derived from the Examiner's Final Office Action dated May 21, 2007 and Non-Final Office Action dated May 18, 2006, both of which are attached in Appendix II.

A. Whether Claims 1, 2, 7-10, 12-15, 17-25, 27 and 31-36 are unpatentable under 35 U.S.C. § 103 over Walker in view of Roll

The Examiner rejected claims 1, 2, 7-10, 12-15, 17-25, 27 and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Application Pub. No. 2003/0054888, to Walker, *et al.*, (hereinafter, referred to as "Walker") in view of United States Patent Application Pub. No. 2003/0016779, to Roll, *et al.* (hereinafter, referred to as "Roll"). The Examiner opined that Walker discloses the claimed invention except for retrieving product information from a database storing third party retail vendor product information. (*See*, Final Rejection Page 3, first paragraph). The Examiner argued that "it would have been obvious at to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system." (Non-Final Office dated May 18, 2006).

B. Whether Claims 3-5 and 29 are unpatentable under 35 U.S.C. § 103 over Walker in view of Roll and Yoseloff

Claims 3-5 and 29 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 6,331,143, to Yoseloff, *et al.*, (hereinafter referred to as "Yoseloff"). The Examiner stated that "Yoseloff teaches about a system where a player selects a number and the system generates a random

number, and a winning outcome is indicated if the user-chosen number...” *See*, Office Action of May 18, 2006, page 11, second paragraph. According to the Examiner, it would have been obvious to combine Yoseloff with Walker and Roll to generate the embodiments claimed in claims 3-5 and 29. *Id.*

C. Whether Claims 6, 11, 16, 26 and 28 are unpatentable under 35 U.S.C. § 103 over Walker in view of Roll and Angles

The Examiner rejected claims 6, 11, 16, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 5,933,811, to Angles, *et al.*, (hereinafter referred to as “Angles”). The Examiner stated that “Angles teaches a system where users are compensated for viewing sponsors’ advertisements. *See*, Office Action dated May 18, 2006, page 13, third paragraph. The Examiner argued that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsor’s advertisements independently of the purchase of the advertised product or service as taught by Angles” *Id.*

D. Whether Claim 30 is unpatentable under 35 U.S.C. § 103 over Walker in view of Roll, Angles and Yoseloff

Claims 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker, in view of Roll, Angles and Yoseloff. The Examiner recognized that Walker “fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.” *See*, Office Action dated May 18, 2006, page 14,

third paragraph. The Examiner stated that it would have been obvious “to know that sponsors would compensate users for viewing the sponsors’ advertisements or for participating in the sponsors’ online surveys.” *See*, Office Action dated May 18, 2006, page 13, third paragraph.

VIII. ARGUMENT

A. Claims 1, 2, 7-10, 12-15, 17-25, 27, and 31-36 Are Patentable Over the Combination of the Prior Art Because There is No Motivation to Combine the References

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, 27, and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, United States Patent Application Pub. No. 2003/0054888 (hereinafter, referred to as “Walker”) in view of United States Patent Application Pub. No. 2002/0016779 (hereinafter, referred to as “Roll”).

The Examiner rejected independent claims 1, 10, 15, 21, 22, 33, 35 and 36 by applying the same arguments to each claim. Applicant respectfully asserts that Claim 1 is representative of independent Claims 10, 15, 21, 22, 33, 35 and 36, and that these independent claims stand or fall together. Furthermore, Claims 2-9 and 31-32 depend from independent Claim 1, Claims 11-14 depend from independent Claim 10, Claims 16-20 depend from independent Claim 15, Claims 23-30 depend from independent Claim 22, and claim 34 depends from independent Claim 33. By virtue of their dependencies, Claims 2-9, 11-14, 26-20, 23-32 and 34, have at least all of the features and limitations as the Claims from which they depend, and, therefore, stand or fall with the claims from which they ultimately depend.

The Examiner cited Walker as showing every element of each of the independent claims; however, the Examiner admitted that Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product

information. *See*, Office Action dated 5/18/2006, page 3. In the Examiner's view, "Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and received back a comparative list of providers of said item." *Id.* In addition, according to the Examiner, "Walker teaches third party manufacturers of products." *Id.* As a result, the Examiner opined that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products." *Id.* Accordingly, the Examiner concluded that the combination of references "would show to users the best third-party vendors' offers of products selected by users." *Id.*

In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

Applicants respectfully submit that there is no motivation to combine the references. It is well settled that an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See, In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Furthermore, the Supreme Court has recently reiterated that "a patent composed of several elements is not proved obvious by demonstrating that each of its elements was, independently, known in the prior art." *See, KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) at 1741.

“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant art to combine the elements in a way that the new invention does.” *Id.*

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Applicants respectfully submit that there is no rationale for the combination of Walker and Roll. In the present rejection, the Examiner stated, with respect to the combination of Walker in view of Roll that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of “the best third-party vendors’ offers of products selected by users.” See, Office Action date May 21, 2006, page 3.

The prior art references relied upon by the Examiner fail to provide any rationale for the combination asserted by the Examiner in rejecting the pending claims. The Examiner has further failed to provide any sort of rationale for the supposed obviousness to combine Walker and Roll. More specifically, the Examiner simply stated that “it would have been obvious to a person of ordinary skill...to know that Walker would be motivated to display to users a list of different third party vendors of user’s selected products.” See, Final Office Action dated May 21, 2006, page 8.

Applicants respectfully submit that the proffered motivation is insufficient to support a *prima facie* case of obviousness. Walker discloses a system and method wherein an individual retailer can increase the excitement associated with the shopping experience. See, Walker, page

3, paragraphs [0022, 0041]. The increased excitement attracts a greater number of customers capable of purchasing items at the retail store. These customers, in turn, are induced to purchase some of the retail store's products, increasing the overall profitability of the retail store. *See*, Walker, page 2, paragraph [0022].

According to Walker, to increase the excitement associated with shopping, a customer has the option to win a product from a retail store outright for a small percentage of the item's cost. *See*, Walker, paragraph [0041]. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. *See*, Walker, paragraph [0096]. The product can be manufactured by a third-party, however, it must be offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits. *See*, Walker, paragraphs [0092, 0096, 0106].

Roll discloses a method wherein a user utilizes a search engine to search multiple providers for a product by using a program which is accessed from the Internet. *See*, Roll, paragraphs [0036, 0037]. After searching for the product, the user receives a comparative list of retailers (or other entities) that offer the item as well as terms (i.e., the price) for the item. *See*, Roll, paragraph [0040]. The system, in turn, allows a user to purchase products and services from competing retailers. *Id.*

i. Roll teaches away from Walker

Applicants respectfully submit that Roll teaches away from any combination with Walker. Therefore, a practitioner skilled in the art of online marketing would not be compelled to look to Roll to improve upon the shortcomings of Walker. The system of Walker results in *increased* profits for a single retail store, while Roll teaches a system that is designed for use by

multiple retailers which results in *lower* profits for the retailers via lowered prices to the consumer. Indeed, in describing the state of the art, Roll describes the typical use of pricing mechanisms as follows:

“Heretofore, available pricing mechanisms are primarily designed to promote transactions within either a) the line of service of the entity providing the listing (e.g., web sites, insurance company websites, mortgage company web sites, insurance company web sites, *retail stores* and discount stores...” See, Roll, paragraph [0006], emphasis added.

Roll also discloses the inherent flaws in such a system:

“Users may use these various pricing mechanisms in an effort to find the best terms for the purchase of an item. However, the users’ motivation can be in conflict with the motivation of the entity providing the pricing information, often the seller. The seller’s motivation is oftentimes to maximize profit, which means conducting the highest number of transactions with the highest margin possible.” See, Roll, paragraph [0007].

Roll explicitly describes the process taught by Walker as deficient. *Id.* Roll points out that a seller controlled system is designed to maximize profits *for the seller*, while still conducting the highest number of transactions possible. *Id.* Indeed, in light of the deficiencies of the system disclosed in Walker, one of the objects of Roll’s invention is to “enable the purchase of products and services from *competing* product/service providers.” See, Roll, paragraph [0013], emphasis added. Accordingly, one of ordinary skill in the art would not be motivated to combine the two references because the references expressly teach away from each other. In teaching away from combination with the likes of Walker, Roll describes the primary features taught by Walker as deficient, and seeks to surmount the shortcomings by providing a system and method benefitting a different audience. See, Roll, paragraph [0007].

In addition, neither of the cited references provide any other motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be

the result of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

Accordingly, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

Under the circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." *Id.*

Applicants submit that the only "motivation" for the Examiner's combination of the references is provided by the teachings of Applicant's own disclosure. No such motivation is provided by the references themselves. Therefore, the rejection should be withdrawn.

ii. Walker would be inoperative if combined with Roll

Applicants further assert that, if the references were combined using the rationale proffered by the Examiner, Walker would be rendered inoperative for its intended purpose. According to the Examiner, "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to

users a list of different third-party providers vendors of users' selected products." *See*, Office Action dated May 21, 2006, page 3. However, such a combination would result in a state where Walker competed with itself by offering products sold by the competition. Accordingly, the system of Walker would not operate as intended, by offering its products with the added incentive of a chance to win a product. Rather, it would allow users the opportunity to win a product without the benefit of a possible sale, which may go to the third party vendor. Indeed, the Examiner admitted that such a combination would show to users the best third-party offers of products selected by users. *See*, Office Action dated May 21, 2006, page 3.

It is well settled that "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Since the Examiner's proposed modification of Walker in view of Roll would render Walker unsatisfactory for its intended purpose, there can be no motivation to combine the references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

iii. The combination of Walker and Roll fails to render the claimed invention obvious

Even if the combination of Walker and Roll is proper, the combined references do not disclose the present invention. The resulting system of Walker in view of Roll would result in a system that provides a user with the opportunity to win or directly purchase a particular product from the party offering the product for sale. In addition, the combination would allow third-

party vendors to compete with the individual retailer by offering the item directly to the user at a lower cost.

More specifically, the Examiner contends that Walker teaches the purchase of a product from the third-party retail vendor. *See*, Office Action dated May 21, 2006, page 4. Applicants respectfully disagree. Walker does not allow a user to purchase a product from a third-party vendor. Instead, if the user wins a product, the customer is charged a game fee and receives the item directly from the offeror of the game. *See*, Walker, Abstract.

In contrast, the present invention comprises an improved shopping search engine. *See*, Abstract. When a user enters criteria related to a specific product, the search engine displays one or more third-party web pages that offer the particular product for sale. *See*, Page 1, paragraph [0025]. When the results are displayed, the user has the option to attempt to win the prize via one or more games of chance. *Id.* Alternatively, the user can simply click on one of the third-party vendor's links and purchase the product. *Id.* Both options are available to the user from one interface immediately after generating the appropriate search. If the user wins the product, the search engine purchases the product from the third-party vendor on behalf of the user. *See*, Page 2, paragraph [0032]. As a result, the present invention does not directly offer products for sale.

Thus, the present invention for the first time discloses a novel search engine with an option to win the item sought. This represents a vast improvement over the prior art. Further, the cited references neither teach nor suggest the novel and non-obvious features of this invention.

Applicant, therefore, respectfully requests the Board's withdrawal of the Examiner's §103(a) rejection of Claim 1. Furthermore, as claims 2-36 stand or fall with Claim 1, Applicant respectfully asserts that Claims 2-36 are patentable over the cited prior art references for at least

the same reasons as those discussed above for Claim 1, and respectfully request the Board's withdrawal of the Examiner's §103(a) rejection of Claims 2-36.

B. Claims 3-5 and 29 Are Patentable Over the Prior Art Because There is No Motivation to Combine the References and the Combination of References Fail to Teach Every Element of the Claims

Claims 3-5 and 29 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of Yoseloff, *et al.*, United States Patent No. 6,331,143. (hereinafter referred to as "Yoseloff"). In the Office Action dated May 21, 2007, the Examiner asserted that the Yoseloff teaches a system for determining a winning game by generating a random number and displaying the resulting random number. *See, e.g.* Office Action May 18, 2006, page 11, second paragraph.

Claims 3-5 depend from independent claim 1, while claim 29 depends from independent Claim 22. Applicants respectfully reassert that independent Claims 1 and 22 are patentable over the cited prior art, as discussed above. Due to their dependencies on Claims 1 and 22, respectively, Claims 3-5 and 29 are patentable for at least the same reasons as Claims 1 and 22.

The Applicant further asserts that Claims 3-5 and 22 are patentable over the combination of Walker, Roll, and Yoseloff because these three cited prior art references fail to teach, suggest, or render obvious in any way, all of the limitations of claims 3-5 and 29.

i. The combination of Walker, Roll and Yoseloff fails to render the claimed invention obvious

Claims 3 and 29 recite similar elements, and were addressed together by the Examiner with a single argument. Claims 4 and 5 depend from claim 3, and, thus, stand or fall with Claim 3. Claim 3 depends directly from Claim 1, and recites:

“the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.”

Applicants respectfully assert that Walker, Roll and Yoseloff, taken singly, or in any combination, fail to remotely render obvious the features recited in Claim 3.

Claim 3 recites the feature of indicating a winning or losing outcome by displaying a number for comparison to a user's chosen number. The matching of the comparison number to the user's number indicates the pseudo-random outcome “corresponding to the calculated probability of winning”, as recited in claim 1. Applicants particularly draw the Board's attention to the fact that the comparison number is an element merely used for display, while the generated pseudo-random outcome recited in claim 1 is used to actually determine whether a user wins the game being played.

In contrast, as cited by the Examiner (*See*, Office Action dated May 18, 2006), Yoseloff teaches a video numbers game, similar to a lottery. *See*, Yoseloff, column 3, lns. 37-57, column 4, lns. 30-39. The numeric embodiment discussed by Yoseloff covers “a game which is similar to a daily numbers game...a single four digit number is selected by the player and a single four digit number is randomly selected by the microprocessor.” *See*, Yoseloff, column 8, lns. 35-43.

Under Yoseloff, the odds of a user winning the game are determined by the number of symbols or size of the number range from which the user may select. *See*, e.g. Yoseloff, column 8, lns. 37-42. Therefore, a user's odds of winning are fixed in relation to the preselected number of symbols. Yoseloff reiterates this point by stating "in the most preferred embodiment of the present invention, payout amounts for the basic numbers game are based solely on the probability of occurrence of each winning outcome without consideration for either the amount already wagered in the game or any other occurrence of a similar winning outcome" (*See*, Yoseloff, column 4, lns. 55-60) and "[t]he present invention contemplates using one or more types of symbols to alter the odds and allow for progressive versions of the game. For example, the four ball example of the present invention could be played with two different ball colors in the set. Alternatively, a much larger set of one type of symbols could be used." *See*, Yoseloff, column 9, lns. 21-26.

Therefore, Yoseloff teaches that the odds of winning are equal to the odds of two different symbol sets, or numbers, matching. In other words, the odds of winning a game, according to the teachings of Yoseloff, the outcome of the game is not pseudo-random, it is random. As cited above, Yoseloff discloses that the odds of winning are determined by changing the number of possible combinations, and that the outcome is random. Thus, under Yoseloff, any display of the outcome is a display of a random outcome, and not a display *indicating* a pseudo-random outcome. Furthermore, the number generated by the processor in Yoseloff, which the Examiner equates to the comparison number of Claim 3, determines the outcome of the game.

In contrast, Claim 3 recites that the displayed user-selected and comparison numbers *indicate* the pseudo-random outcome. Thus, the pseudo-random outcome is separate from the displayed numbers of Claim 3. According to the present principles, the odds of winning a

particular prize may be modified or tweaked based on the number of previous wins, the current prize budget, or the like. *See*, Pages 3-4, paragraphs [0058-0094]. It would be impossible to apply the fixed probabilities of Yoseloff to Claim 3 without significantly modifying the goals, process and results of Yoseloff or Claim 3.

It would not be obvious to even a highly skilled practitioner of the art to use the number comparison taught by Yoseloff, singly, or in any combination with Walker and Roll, to develop the display or the pseudo-random results recited in Claim 3. Similarly, Walker, Roll and Yoseloff fail to anticipate, suggest, or render obvious in any way, all of the elements of Claim 29.

Claims 4 and 5 depend directly from claim 3, and by their dependencies, include all of the features and elements recited in claim 3. Therefore, claims 4 and 5 are patentably distinct and non-obvious over the cited combination of Walker, Roll and Yoseloff for at least the same reasons as claim 3. In light of such non-obviousness, Applicants respectfully solicit the Board's reversal of the Examiner's §103 rejection of Claims 3-4 and 29.

C. Claims 6, 11, 16, 26 And 28 Are Patentable Over the Prior Art Because There is No Motivation to Combine the References and the Combination of References Fail to Teach Every Element of the Claims

The Examiner rejected claims 6, 11, 16, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 5,933,811, to Angles, *et al.* (hereinafter referred to as "Angles").

The Examiner asserts that "Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lns. 38-45). Therefore, it would have been

obvious... to know that users of the Walker system would be compensated for viewing of select sponsors' advertisements independently of the purchase of the advertised product or service... and these compensations would allow users to play games to win the sponsors' advertise products." See, Office Action dated May 21, 2007, page 13, third paragraph.

i. The combination of Walker, Roll and Angles fails to render the claimed invention obvious

Claim 6 depends from independent claim 1, Claim 11 depends from independent Claim 10, Claim 16 depends from independent Claim 15, and Claims 26 and 28 depend from independent Claim 22. Applicants respectfully reassert that independent claims 1, 10, 15 and 22 are patentable over the cited prior art, as discussed above, and that Claims 6, 11, 16, 26 and 28 are patentable for at least the same reasons as Claims 1, 10, 15 and 22 due to their dependencies on the respective patentable independent claims.

Applicants further assert that the combination of Walker, Roll and Angles fails to render obvious all of the elements of Claims 6, 11, 16, 26 and 28. Claim 6 is representative of Claims 11, 16, 26 and 28. The cited prior art references particularly fail to teach, suggest, or in any way render obvious, at least the element of "providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation" as recited in Claim 6.

The Examiner appears to have equated paying a user for viewing an advertisement, as taught by Angles, with increasing a user's chance of winning in exchange for performing a task, as recited in Claim 6. Applicants respectfully dispute the Examiner's assertion that these two method steps are equivalent.

While the Examiner opines that “[c]ompensating users for viewing advertisements would be a good business decision as this would increase the probability that the users would view the sponsors’ advertisements and would play to win the advertised products, therefore increasing customer traffic and customer loyalty”, (See, e.g., Office Action dated May 21, 2007, page 14, first paragraph), Claim 6 does not recite any element where a user is compensated. In fact, according to the specification, “In return for directing the user to the sponsor’s web site, *the system receives revenue* from the sponsor. A portion of the revenue received is allocated to the prize budget, and the odds management component 107 increases the user’s probability of winning in response.” See, Page 6, paragraph [0095], emphasis added. Thus, when interpreted in light of the specification, Claim 6 clearly provides that the *system*, instead of a user, is compensated.

The Examiner’s assertions regarding successful business practices notwithstanding, having a third party directly compensate a user, as taught by Angles, gives the user the opportunity to keep any earned money without the referring website operator having the chance to recapture a portion of the money paid by a sponsor for a user viewing an advertisement. See, Angles, Column 16, lns. 35-37. In contrast, Claim 6 recites a method where the providing system retains all payments from third parties, awarding prizes based on a prize budget. See, Page 5, paragraph [0094]. Therefore, the teachings of Angles have no bearing on the elements recited in Claim 6.

The specification further illustrates that a user does not necessarily need to view an advertisement to increase their odds of winning a game. The specification recites: “[A] user’s probability of winning increases, for example, through continued play.” See, e.g., Page 6, paragraph [0096]. In such an embodiment, no compensation is paid to the system or the user.

Therefore, even a practitioner highly skilled in the art would not look to Angles to provide a solution for increasing a user's odds of winning by performing a task.

Furthermore, there is no indication in Angles that a user would use any compensation from a third party to play any game provided according to Angles. The mere hope that a user might use their compensation under Angles to play the paid game of chance taught by Walker and Roll cannot amount to obviousness.

Thus, Angles fails to render obvious the Claim 6 element of "providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation" because Angles presents no teaching that a skilled artisan would find obvious to develop into such an element. Therefore, Claim 6 is patentably distinct and nonobvious over the combination of Walker, Roll and Angles fails to render Claim 6.

Claims 11, 16, 26 and 28 all have elements analogous to, or depend from claims having analogous elements to, the element discussed above for claim 6. Therefore, Claims 11, 16, 26 and 28 are patentable for at least the same reasons as discussed above for Claim 6.

In light of the foregoing arguments, Applicants respectfully request the Board's reversal of the Examiner's §103(a) rejection of Claims 6, 11, 16, 26 and 28.

D. Claim 30 is Patentable Over the Prior Art Because There is No Motivation to Combine the References and the Combination of References Fail to Teach Every Element of the Claim

The Examiner rejected Claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Walker, in view of Roll, Angles and Yoseloff. The Examiner asserts that Angles teaches a method for providing a user an opportunity to increase the probability of winning a product or

service by participating in an online survey. *See*, Office Action dated May 18, 2007, page 14, third paragraph.

i. The combination of Walker, Roll, Angles and Yoseloff fails to render the claimed invention obvious

Claim 30 depends from Claim 29, and recites "The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor." The element recited by Claim 30 is analogous to that discussed above for Claims 6, 11, 16, 26 and 28. Therefore, by virtue of its dependency on Claim 29, Claim 30 has all of the features and limitations of Claim 29, is patentable over the cited art for at least the reasons set forth above for claim 29. Applicants further assert that, by having an limitation analogous to Claims 6, 11, 16, 26 and 28, Claim 30 is further patentable over the cited prior art for at least the same reasons as Claims 6, 11, 16 26 and 28.


Applicants respectfully solicit the Board's reversal of the Examiner's §103(a) rejection of Claim 30.

XI. CONCLUSION

For at least the foregoing reasons, Applicant respectfully solicits the Board's reversal of the Examiner's rejections of Claims 1-36.

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APPENDIX I: CLAIMS

1. A method of providing a user with a game of chance, the method comprising the steps of:
 - receiving electronic signals from a user system representing search parameters descriptive of a product;
 - retrieving at least one product information from at least one database storing third-party retail vendor product information;
 - transmitting electronic signals to the user system representing product information and associated prices;
 - automatically providing the user with an option to play a game to win a selected product from said product information without the user first making any payment or requesting the option;
 - electronically calculating a probability of winning the selected product by the user;
 - electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; and
 - in response to a winning pseudo-random outcome, purchasing the selected product for the user from the third-party retail vendor.
2. The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.

3. The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.
4. The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.
5. The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number.
6. The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.
7. The method of claim 1, comprising calculating a probability of winning based on at least a current budget.
8. The method of claim 1, comprising calculating a probability P of winning based on a total number of game players.
9. The method of claim 1, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

P_t is a probability factor that varies with a current prize budget;

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

P_u is probability factor that varies with the user's behavior during a user session;
and

N is a number of current users.

10. A method of providing a user with a game of chance, the method comprising:
 - receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
 - retrieving at least one product information from at least one database storing third-party retail vendor product information;
 - transmitting electronic signals to the user system representing at least one product, a price of the product and a third-party retail vendor of the product;
 - automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

electronically calculating a probability of winning the product by the user;

electronically generating a pseudo-random outcome corresponding to the

calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing the product for the

user from the third-party retail vendor; and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product.

11. The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation.

12. The method of claim 10, comprising calculating a probability of winning based on at least a current budget.

13. The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

14. The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

P_a is a probability factor that varies with the cost of the selected product in

relation to the total cost of all products available;

Pt is a probability factor that varies with a current prize budget;

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

Pu is probability factor that varies with the user's behavior during a user session;
and

N is a number of current users.

15. A method of providing a user with a game of chance, the method comprising:
 - receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
 - retrieving at least one product information from at least one database storing third-party retail vendor product information;
 - transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter;
 - automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and
 - if the user chooses to play the game:
 - electronically calculating a probability of winning said selected one product by the user;

electronically generating a pseudo-random outcome corresponding to the
calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing said selected one
product from a corresponding third-party retail vendor for the user.

16. The method of claim 15, comprising providing the user with an opportunity to increase
the chances of winning by performing a task for which a third party provides
compensation.

17. The method of claim 15, comprising calculating a probability of winning based on at
least a current budget.

18. The method of claim 15, comprising calculating a probability P of winning based on a
total number of game players.

19. The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

P_a is a probability factor that varies with the cost of the selected product in relation
to the total cost of all products available;

P_t is a probability factor that varies with a current prize budget;

P_m is a probability factor that varies with a ratio of the current prize budget to a
total amount of funds received;

P_u is probability factor that varies with the user's behavior during a user session;
and

N is a number of current users.

20. The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.
21. A method of providing a user with a game of chance, the method comprising:
 - receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
 - searching for products matching said at least one search parameter;
 - transmitting electronic signals to the user system representing a plurality of third-party retail vendors and associated prices charged by each of said third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each third-party retail vendor;
 - automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and
 - if the user chooses to play the game:

electronically calculating a probability of winning said selected one product by
the user;

electronically generating a pseudo-random outcome having a probability
corresponding to the calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing said selected one
product from a corresponding third-party retail vendor for the user.

22. A method for providing a user an opportunity to win a product or service by playing a
game of chance without buying the product or service and without paying a fee to play,
comprising the steps of:

enabling the user to submit a search query associated with a type of product or
service;

conducting a search in a database for a third-party retail vendor product or service
that satisfies the search query;

automatically presenting a result of the search to the user, including at least one
product or service offered for sale by said third-party retail vendor

retrieved from the database, along with an option to play the game;

enabling the user to select the product or service that he wants to win;

determining the user's chance of winning the selected product or service;

generating an outcome for each play of the game that corresponds to the user's
chance of winning; and

displaying the outcome of the game to the user.

23. The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win.
24. The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.
25. The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.
26. The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.
27. The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.

28. The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor for a game provider which increases the user's chance of winning the selected product or service.
29. The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each play of the game.
30. The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.
31. The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user.
32. The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product.
33. A method for increasing user traffic to a search engine website, comprising:

receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; and transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link.

34. The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party website redirection link.

35. A method for increasing user traffic to a search website, comprising:
providing a search webpage containing a search interface for a user to submit a search query for a product;
receiving a search query from a user employing said search webpage;
searching third party websites by reference to said query;

retrieving product information and corresponding price from said third party websites for
at least one products satisfying said query;
providing a game of chance in response to a user selection of the link to win the product;
and purchasing the product from the third party for the user response to a
favorable outcome in said game;
transmitting at least one results webpage to the user, the results webpage including at
least one link for the product information, a corresponding price, a link to the
third party website, and a link to win the product;
providing a game of chance in response to a user selection of the link to win the product;
and
purchasing the product from the third party for the user in response to a favorable
outcome in said game.

36. A product search website executing on a server storing a plurality of web pages, the website comprising:
- a search page for a user submitting a query to the server for at least one product;
 - a results webpage transmitted to the user, the results page including links to third party website and a link to a play webpage of the website;
 - a play webpage providing a game of chance for winning the product corresponding to a selected play link from the results webpage; and
 - a product win webpage to indicate a favorable outcome in said game of chance for said product.

APPENDIX II: EVIDENCE

Exhibit 1: Final Office Action Dated May 21, 2007

Exhibit 2: Non-Final Office Action dated May 21, 2006

Exhibit 3: Amendment and Request for Continued Examination dated February 27, 2006

APPENDIX III: RELATED PROCEEDINGS

Exhibit 4: Final Office Action dated June 27, 2005, dated June 27, 2005

Exhibit 5: Pre-Appeal Brief Request for Review, dated September 26, 2005

Exhibit 6: Panel Decision from Pre-Appeal Brief Review, dated December 13, 2005

Exhibit 1



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158 7590 05/21/2007 WOMBLE CARLYLE SANDRIDGE & RICE, PLLC ATTN: PATENT DOCKETING 32ND FLOOR P.O. BOX 7037 ATLANTA, GA 30357-0037			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 05/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Office Action Summary

Application No.

09/759,103

Applicant(s)

CLARK ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

Response to Amendment

2. In response to Non Final Rejection filed 05/18/2006, the Applicant filed a Request for reconsideration on 08/18/2006.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25, 27, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Roll (US 2002/0016779).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:
receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product (see Walker

paragraphs 38 and 39). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for said item (see Roll paragraph 57 and abstract, paragraph 61). Rolls also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different third-party providers vendors of users' selected products, as taught by Roll, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a probability of winning the product by the user;
electronically generating a pseudo-random outcome corresponding to the calculated
probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for
the user (see Walker paragraph 145) from the third-party retail vendor (see Walker
paragraph 39);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph
34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the
steps of:

receiving electronic signals from a user system representing search parameters
descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing the retrieved
product information and associated prices (see Walker figure 6). Walker does not
expressly teach retrieving at least one product information from at least one database
storing third-party retail vendor product information. However, the same argument made
in claim 10 regarding this missing limitation is also made in claim 1.

automatically providing the user an option to play a game to win a selected product from said product information without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product for the user from the third-party retail vendor (see Walker paragraph 145; paragraph 39).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning said selected one product by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding third-party retail vendor for the user (see Walker paragraph 145; paragraph 39).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

P_t is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

P_u is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user. However, Roll teaches collecting a database of third party retail vendor prior to receiving a query request from a user (see Roll paragraph 61). Therefore, the same rejection applied to claim 10 regarding the third-party vendor database missing limitation is also made in claim 31.

As per claim 32, Walker teaches:

The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39).

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (see Walker paragraph 39). Walker fails to teach receiving a search query from a user system interacting with a

Art Unit: 3622

search webpage of the website, the search query defining a desired product for the user. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to search for an item via an Internet browser (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for the item (see Roll paragraph 57 and abstract, paragraph 61). Roll also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different third-party providers vendors of users' selected products, as taught by Roll, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

As per claim 34, Walker does not expressly teach:

The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party

website redirection link. However, Roll teaches a search engine website which facilitates the purchase of a product from a third party vendor (see Roll paragraph 57). Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching third party websites by reference to said query. However, the same

rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

4. Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to

the provider of the products (see Walker paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

5. Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker.

Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

Response to Arguments

7. Applicant's arguments filed 11/03/2006 have been fully considered but they are not persuasive. The Applicant argues that there is no motivation to combine Walker with Rolls and that the references teaches away from each other, because according to the Applicant, the Walker reference results in increase profits for a single retail store, while Rolls teaches a system that is designed for use by multiple retailers which result in

lower profits by the retailers via lowered prices to the consumer. The Examiner answers that a user would be motivated to use the Walker and Roll system in order to find the best possible price (i.e. lower price) for a product by comparing the offer price of different providers with the added incentive of allowing said user to play a game in order to obtain said product for free. Therefore, contrary to Applicant's argument, Walker and Roll are combinable.

The Applicant further argues that Walker does not allow a user to purchase a product from a third party vendor because according to the Applicant, if the user wins a product, the customer is charged a game fee and receives the item directly from the offeror of the game. The Examiner answers that Walker teaches an embodiment where is not necessary to pay a fee to play a game (see paragraph 130, 152) and also Walker teaches the purchase of products from websites run by retailers (see paragraph 104). Therefore, contrary to Applicant's argument, Walker allow users to purchase a product from a third party vendor (i.e. retailer).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
March 31, 2007

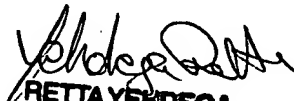

RETTA YEHEGA
PRIMARY EXAMINER

Exhibit 2



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	05/18/2006	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC ATTN: PATENT DOCKETING 32ND FLOOR P.O. BOX 7037 ATLANTA, GA 30357-0037			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,103

Applicant(s)

CLARK ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

Response to Amendment

2. In response to Final Rejection filed 06/27/2005, the Applicant filed an RCE on 03/03/2006, which amended claims 1, 10, 15, 21, 22 and added new claims 31-36.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7-10, 12-15, 17-25, 27, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Roll (US 2002/0016779).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals *from a user system* representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals *to the user system* representing at a least one product, a price of the product and a third-party *retail vendor* of the product (see Walker

paragraphs 38 and 39). Walker does not expressly teach *retrieving at least one product information from at least one database storing third-party retail vendor product information*. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for said item (see Roll paragraph 57 and abstract, paragraph 61). Rolls also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products, which users would like to play games to win said selected products (see Walker paragraphs 38-39). This feature would show to users the best third-party vendors' offers of products selected by users.

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a probability of winning the product by the user; electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145) *from the third-party retail vendor* (see Walker paragraph 39);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals *from a user system* representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals *to the user system* representing the *retrieved product information* and associated prices (see Walker figure 6). Walker does not expressly teach *retrieving at least one product information from at least one database storing third-party retail vendor product information*. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1.

automatically providing the user an option to play a game to win a selected product *from said product information* without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product for the user *from the third-party retail vendor* (see Walker paragraph 145; paragraph 39).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals *from a user system* representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals *to the user system* representing a plurality of different *third-party retail vendors* and associated prices charged by each of said different *third-party retail vendors* for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach *retrieving at least one product information from at least one database storing third-party retail vendor product information*. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.

automatically transmitting electronic signals *to the user system* representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning said selected one product by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding *third-party retail vendor* for the user (see Walker paragraph 145; paragraph 39).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

Walker does not expressly teach P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

P_t is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

P_u is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user. However, Roll teaches collecting a database of third party retail vendor prior to receiving a query request from a user (see Roll paragraph 61). Therefore, the same rejection applied to claim 10 regarding the third-party vendor database missing limitation is also made in claim 31.

As per claim 32, Walker teaches:

The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39).

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (see Walker paragraph 39). Walker fails to teach receiving a search query from a user system interacting with a

search webpage of the website, the search query defining a desired product for the user. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to search for an item via an Internet browser (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for the item (see Roll paragraph 57 and abstract, paragraph 61). Roll also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products, which users would like to play games to win said selected products (see Walker paragraphs 38-39). This feature would show to users the best third-party vendors' offers of products selected by users.

As per claim 34, Walker does not expressly teach:

The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party website redirection link. However, Roll teaches a search engine website which

facilitates the purchase of a product from a third party vendor (see Roll paragraph 57).

Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching third party websites by reference to said query. However, the same rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

5. Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see Walker paragraph 26). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

6. Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as

this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

Response to Arguments

8. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
April 29, 2006

Yehdega Retta
RETTA YEHDEGA
PRIMARY EXAMINER

Exhibit 3



#RCE
JFW

PTO/SB/30 (04-05)

Approved for use through 07/31/2006. OMB 085-00031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Request for Continued Examination (RCE) Transmittal

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	09/759,103
Filing Date	January 12, 2001
First Named Inventor	Clark
Art Unit	3622
Examiner Name	Daniel Lastra
Attorney Docket Number	632-001

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- ii. ☐ Other _____
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/ Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other _____

2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other _____

3. Fees

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.
- The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. 23-0420. I have enclosed a duplicate copy of this sheet.
- a. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☒ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other _____
- b. ☒ Check in the amount of \$ 395.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

03/06/2006 RBIZUNES 00000031 09759103

01 FC:2801

395.00 OP

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature		Date	02/27/2006
Name (Print/Type)	James L. Lynch	Registration No.	54,763

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature		Date	02/27/2006
Name (Print/Type)	James L. Lynch		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/21 (02-04)
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/759,103	
	Filing Date	01/12/2001	
	First Named Inventor	Clark	
	Art Unit	3622	
	Examiner Name	Daniel Lastra	
Total Number of Pages in This Submission	28	Attorney Docket Number	632-001

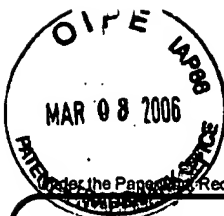
ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input checked="" type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	1. Return Receipt Postcard
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<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	James L. Lynch Reg. No: 54,763
Signature	
Date	February 27, 2006

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	James L. Lynch
Signature	
Date	02/27/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (01-06)

Approved for use through 07/31/2006. OMB 0851-0032

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 395.00

Complete if Known

Application Number	09/759,103
Filing Date	01/12/2001
First Named Inventor	Clark
Examiner Name	Daniel Lastra
Art Unit	3622
Attorney Docket No.	632-001

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 23-0420 Deposit Account Name: Ward & Olivo

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fees Paid (\$)
_____	_____	_____	_____	_____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Request for Continued Examination Fee

Fees Paid (\$)

395.00

SUBMITTED BY

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PATENT APPLICATION FEE DETERMINATION RECORD
 Substitute for Form PTO-875

Application or Docket Number
09/59/103

CLAIMS AS FILED - PART I

FOR	NUMBER FILED	NUMBER EXTRA
BASIC FEE (37 CFR 1.16(a))		
TOTAL CLAIMS (37 CFR 1.16(c))	5 minus 20 =	0
INDEPENDENT CLAIMS (37 CFR 1.16(b))	1 minus 3 =	0
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(d))		

SMALL ENTITY

RATE	FEE
	\$ 355
X \$ 9 =	
X \$ 40 =	
+ \$ =	
TOTAL	355

OR OTHER THAN SMALL ENTITY

RATE	FEE
	\$
X \$ =	
X \$ =	
+ \$ =	
TOTAL	

* If the difference in column 1 is less than zero, enter "0" in column 2.

CLAIMS AS AMENDED - PART II

	(Column 1)	(Column 2)	(Column 3)
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total (37 CFR 1.16(c))	36	Minus 30	= 6
Independent (37 CFR 1.16(b))	8	Minus 5	= 3
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))			

SMALL ENTITY

RATE	ADDITIONAL FEE
X \$ 25 =	225
X \$ 100 =	300
+ \$ =	
TOTAL ADD'L FEE	525

OR OTHER THAN SMALL ENTITY

RATE	ADDITIONAL FEE
X \$ =	
X \$ =	
+ \$ =	
TOTAL ADD'L FEE	

	(Column 1)	(Column 2)	(Column 3)
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total (37 CFR 1.16(c))	38	Minus 38	= 0
Independent (37 CFR 1.16(b))	6	Minus 6	= 0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))			

RATE	ADDITIONAL FEE
X \$ =	
X \$ =	
+ \$ =	
TOTAL ADD'L FEE	

RATE	ADDITIONAL FEE
X \$ =	
X \$ =	
+ \$ =	
TOTAL ADD'L FEE	

	(Column 1)	(Column 2)	(Column 3)
AMENDMENT C	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total (37 CFR 1.16(c))		Minus	=
Independent (37 CFR 1.16(b))		Minus	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))			

RATE	ADDITIONAL FEE
X \$ =	
X \$ =	
+ \$ =	
TOTAL ADD'L FEE	

RATE	ADDITIONAL FEE
X \$ =	
X \$ =	
+ \$ =	
TOTAL ADD'L FEE	

- * If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
- ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
- *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In re Application of: Clark *et al.*

5

Serial No.: 09/759,103

Group Art Unit: 3622

Filed: January 12, 2001

Examiner: Daniel Lastra

For: SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT Atty. Docket No.: 632-001

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

10

AMENDMENT AND REQUEST FOR CONTINUED EXAMINATION

S I R:

In response to the December 13, 2005 Notice of Panel Decision from Pre-Appeal Brief

15 Review and the Final Office Action dated June 27, 2005 in the above mentioned case, Applicants respectfully request reconsideration in view of the following amendments and remarks:

Amendments to the Claims begin on Page 2 of this paper.

20 **Remarks** begin on Page 17 of this paper.

IN THE CLAIMS

This listing of claims shall replace all prior versions and listings of claims in the application:

1. (Currently amended) A method of providing a user with a game of chance, the method
5 comprising the steps of:

receiving electronic signals from a user system representing search
parameters descriptive of a product ~~or service~~;

retrieving at least one product information from at least one database storing
third-party retail vendor product information;

10 transmitting electronic signals to the user system representing ~~dealers in the~~
retrieved product or service information and associated prices;

automatically providing the user with an option to play a game to win a selected
product ~~or service~~ from said product information without the user first
making any payment or requesting the option;

15 electronically calculating a probability of winning the selected product ~~or service~~
by the user;

electronically generating a pseudo-random outcome corresponding to the
calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing the selected
20 product ~~or service~~ for the user from the third-party retail vendor.

2. (Previously presented) The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.

5 3. (Previously presented) The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.

10

4. (Previously presented) The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.

15

5. (Previously presented) The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number.

20 6. (Previously presented) The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.

7. (Previously presented) The method of claim 1, comprising calculating a probability of winning based on at least a current budget.

8. (Previously presented) The method of claim 1, comprising calculating a probability P of winning based on a total number of game players.

9. (Previously presented) The method of claim 1, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

P_t is a probability factor that varies with a current prize budget;

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

P_u is probability factor that varies with the user's behavior during a user session;
and

N is a number of current users.

10. (Currently amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

5 retrieving at least one product information from at least one database storing third-party retail vendor product information;

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party ~~dealer~~ retail vendor of the product;

10 automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

15 electronically calculating a probability of winning the product by the user;
electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing the product for the user from the third-party retail vendor; and

20 if the user chooses to purchase the product instead of playing the game:
directing the user to a web site which sells the product.

11. (Previously presented) The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation.

5 12. (Previously presented) The method of claim 10, comprising calculating a probability of winning based on at least a current budget.

13. (Previously presented) The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

10

14. (Previously presented) The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

15

where:

P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

P_t is a probability factor that varies with a current prize budget;

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

20

P_u is probability factor that varies with the user's behavior during a user session;
and

N is a number of current users.

15. (Currently amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

5 retrieving at least one product information from at least one database storing third-party retail vendor product information;

transmitting electronic signals to the user system representing a plurality of different ~~dealers~~ third-party retail vendors and associated prices charged by each of said different ~~dealers~~ third-party retail vendors for products identified in response to said at least one search parameter;

10 automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

if the user chooses to play the game:

15 electronically calculating a probability of winning said selected one product by the user;

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; and

20 in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding ~~dealers~~ third-party retail vendor for the user.

16. (Previously presented) The method of claim 15, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.

5 17. (Previously presented) The method of claim 15, comprising calculating a probability of winning based on at least a current budget.

18. (Previously presented) The method of claim 15, comprising calculating a probability P of winning based on a total number of game players.

10

19. (Previously presented) The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

15

where:

P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

P_t is a probability factor that varies with a current prize budget;

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

20

P_u is probability factor that varies with the user's behavior during a user session;

and

N is a number of current users.

20. (Previously presented) The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.

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21. (Currently amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

5 searching for products matching said at least one search parameter;

transmitting electronic signals to the user system representing a plurality of

~~dealers~~ third-party retail vendors and associated prices charged by each of said ~~dealers~~ third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being
10 offered for sale on a corresponding web site of each ~~dealer~~ third-party retail vendor;

automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

15 if the user chooses to play the game:

electronically calculating a probability of winning said selected one product by the user;

electronically generating a pseudo-random outcome having a probability corresponding to the calculated probability of winning; and

20 in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding ~~dealer~~ third-party retail vendor for the user.

22. (Currently amended) A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service;

conducting a search in a database for a third-party retail vendor product or service that satisfies the search query;

automatically presenting a result of the search to the user, including at least one product or service offered for sale by said third-party retail vendor

retrieved from the database, along with an option to play the game;

enabling the user to select the product or service that he wants to win;

determining the user's chance of winning the selected product or service;

generating an outcome for each play of the game that corresponds to the user's chance of winning; and

displaying the outcome of the game to the user.

23. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win.

24. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.

25. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.

26. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.

27. (previously presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.

28. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor for a game provider which increases the user's chance of winning the selected product or service.

29. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each play of the game.

5

30. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.

10 31. (New) The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user.

15 32. (New) The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product.

20

33. (New) A method for increasing user traffic to a search engine website, comprising:
receiving a search query from a user system interacting with a search webpage of the
website, the search query defining a desired product for the user; and
transmitting a results webpage to the user system, the results page including at least one
link for redirection to a third party vendor website where the user system can
interact with at least one webpage to purchase a corresponding product and
further including in the same webpage a play link corresponding to said third
party vendor link for redirection to a webpage which allows the user to play a
game of chance to win the product corresponding to the third party website
redirection link.

34. (New) The method of claim 33, wherein said play link webpage is provided by the search
engine website and wherein the search engine website calculates the outcome of the game
of chance for a user system selecting to play to win the product and further wherein if the
user outcome is favorable the search engine website facilitating the purchase of the
product from the third party vendor corresponding to the third party website redirection
link.

35. (New) A method for increasing user traffic to a search website, comprising:
providing a search webpage containing a search interface for a user to submit a search
query for a product;
receiving a search query from a user employing said search webpage;
5 searching third party websites by reference to said query;
retrieving product information and corresponding price from said third party websites for
at least one products satisfying said query;
providing a game of chance in response to a user selection of the link to win the product;
and purchasing the product from the third party for the user response to a
10 favorable outcome in said game;
transmitting at least one results webpage to the user, the results webpage including at
least one link for the product information, a corresponding price, a link to the
third party website, and a link to win the product;
providing a game of chance in response to a user selection of the link to win the product;
15 and
purchasing the product from the third party for the user in response to a favorable
outcome in said game.

36. (New) A product search website executing on a server storing a plurality of web pages, the website comprising:

a search page for a user submitting a query to the server for at least one product;

a results webpage transmitted to the user, the results page including links to third party

5 website and a link to a play webpage of the website;

a play webpage providing a game of chance for winning the product corresponding to a

selected play link from the results webpage; and

a product win webpage to indicate a favorable outcome in said game of chance for said

product.

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REMARKS

Initially, Applicants have amended claims 1, 10, 15, 21, and 22. In addition, Applicants have added new claims 31-36. No new matter has been added. Applicants believe that the foregoing comments overcome the rejections set forth in the June 27, 2005 Office Action. A Request for Continued Examination is being filed concurrently with this response.

I. THE EXAMINER'S REJECTIONS

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, U.S. Patent Application Pub. No. 2003/0054888 (hereinafter "Walker") in view of Ghouri *et al.*, U.S. Patent Application Pub. No. 2002/0082978 (hereinafter "Ghouri").

The Examiner rejected independent claims 1, 10, 15, 21 and 22 by applying the same arguments to each claim. More specifically, the Examiner cited Walker to show every element of independent claims 1, 10, 15, 21 and 22; however, the Examiner admitted that Walker does not expressly teach the use of dealers. *See, e.g.*, Office Action dated 6/27/2005, page 4. In the Examiner's view, "Ghouri teaches a system that searches for dealers of products selected by users." *Id.* In addition, according to the Examiner, "Walker teaches third party manufacturers of products." *Id.* As a result, the Examiner opined that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products." *Id.* Accordingly, the Examiner concluded that the combination of references "would show to users the best dealers or manufacturers' offers of products selected by users." *Id.*

II. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

Applicants respectfully submit that there is no motivation to combine the references. It is well settled that an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Indeed, the Examiner "has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination." *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *see also, In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997) ("When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references of make modification."). A finding of obviousness is not warranted if, as in the present case, there is an absence of such teaching, suggestion or

motivation. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). The prior art references relied upon by the Examiner fail to provide any teaching, suggestion or motivation for the combination asserted by the Examiner in rejecting the pending claims. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is

some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

More specifically, Applicants respectfully submit that there is no motivation for the combination of Walker in view of Ghouri. In the present rejection, the Examiner stated, with
5 respect to the combination of Walker in view of Ghouri that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users’ selected products.” *See* Office Action, page 4.

Applicants respectfully submit that the proffered motivation is improper. Walker
10 discloses a method wherein an individual retailer can increase the excitement associated with the shopping experience. The increased excitement attracts a greater number of customers capable of purchasing items at the retail store. These customers, in turn, are induced to purchase some of the retail store’s products, increasing the overall profitability of the retail store.

To increase the excitement associated with shopping, a customer has the option to win a
15 product from a retail store outright for a small percentage of the item’s cost. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. The product can be manufactured by a third-party, however, it must be offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits.

20 Ghouri discloses a method wherein a user customizes a product, such as an automobile, by using a program which is accessed from the Internet. After customizing the product, the user stores the results in a database for a fee. After the information is stored and the fee is paid, a notification is sent to multiple participating retailers of the customizable product. The retailers,

in turn, offer the product to the user for a specified price. Each retailer has access to the other offers, and can modify its offer accordingly. For example, if the retailer wants to sell the item but does not have the lowest offer, it may lower the asking price for the product to make it more attractive for purchase by a user. The system, known as a reverse auction, is designed to provide the user with the lowest possible price for a particular product. As a result, a retailer who uses the Ghouri system will actually receive less profit for a product than it normally would.

As a result, Applicants respectfully submit that the references teach away from each other. As such, they are not combinable. For example, the Walker reference results in increased profits for a single retail store, while Ghouri teaches a system that is designed for use by multiple retailers which results in lower profits by the retailers via lowered prices to the consumer.

Accordingly, one of ordinary skill in the art would not be motivated to combine the two references. In addition, the cited references provide no other motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

Accordingly, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

At best, it might be obvious to *try* such a modification, but of course, “obvious to try” is not the standard for obviousness under 35 U.S.C. § 103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, Applicants respectfully submit that the Examiner has
5 succumbed to the “strong temptation to rely on hindsight.” *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

10 “It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law.” *Id.*

Applicants submit that the only “motivation” for the Examiner’s combination of the references is provided by the teachings of Applicant’s own disclosure. No such motivation is provided by the references themselves. Therefore, the rejection should be withdrawn.

15 Further, if the references were combined using the rationale proffered by the Examiner, Walker would be rendered inoperative for its intended purpose. According to the Examiner, “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users’ selected products.” *See* Office Action, page 4. However,
20 such a combination would result in a state where Walker competed with itself by offering products sold by the competition. Accordingly, the system of Walker will not operate as intended, by offering its products with the added incentive of a chance to win a product, but rather would allow users the opportunity to win a product without the benefit of a possible sale, which may go to the third party vendor. Indeed, the Examiner admitted that such a combination
25 “would show to users the best dealers or manufacturers’ offers of products selected by users.” *See* Office Action, page 4.

It is well settled that “if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Since the Examiner’s
5 proposed modification of Walker in view of Ghouri would render Walker unsatisfactory for its intended purpose, there can be no motivation to combine the references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

Even if the combination of Walker and Ghouri is proper, the combined references do not
10 disclose the present invention as amended. The resulting system of Walker in view of Ghouri would result in a system that provides a user with the opportunity to win or directly purchase a particular product from the party offering the product for sale. In addition, the combination would allow third-party vendors to compete with the individual retailer by offering the item directly to the user at a lower cost.

15 In contrast, the present invention comprises an improved shopping search engine. When a user enters criteria related to a specific product, the search engine displays one or more third-party web pages that offer the particular product for sale. When the results are displayed, the user has the option to attempt to win the prize via one or more games of chance. Alternatively, the user can simply click on one of the third-party vendor’s links and purchase the product. Both
20 options are available to the user from one interface immediately after generating the appropriate search. If the user wins the product, the search engine purchases the product from the third-party vendor on behalf of the user. As a result, the present invention does not directly offer products for sale.

In addition, the present invention merely lists third-party vendors who offer the product that a user wishes to purchase and/or win. It does not directly offer products for sale to a user, nor does it allow third-party vendors to compete with each other via a reverse auction as required by Ghouri. Neither Walker nor Ghouri discloses a search engine which provides the user with an opportunity to purchase the product from a third-party vendor as required by the amended claims. Instead, Walker discloses the direct sale of a product which can be manufactured by third parties by an individual retailer. Ghouri requires that the third party vendors offer the product directly to the consumer. It does not allow the consumer to purchase the product in response to a search query. Rather, a user of the Ghouri system must wait until she receives an offer for the desired product. Since Walker and Ghouri, individually and in combination, fail to disclose the present invention as amended. Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103 is improper and should be withdrawn:

Further, the present invention does not require the user to input any sensitive personal information to win the item sought. The systems of Ghouri and Walker require the end user to enter information related to the user's name, address, and credit card information, which can be tracked by marketing agencies and the like to determine a user's buying tastes, etc. As a result, the user frequently receives unwanted promotional materials based on the inputted information. In contrast, the present invention does not require the user to input any sensitive personal information. A user of the present invention merely enters a contest with a predetermined winning percentage. Consequently, the user of the present information does not receive unwanted promotional materials and the like.

Thus, the present invention for the first time discloses a novel search engine with an option to win the item sought. This represents a vast improvement over the prior art. Further,

the cited references neither teach nor suggest the novel and non-obvious features of this invention.

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CONCLUSION

Applicants submit that the specification, drawings, and all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. The claims have been amended merely to clarify the novel features of the current invention and are in no way related to patentability. Early and favorable action is accordingly solicited.

Respectfully submitted,

Date: 2-27-06

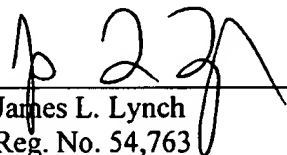

James L. Lynch
Reg. No. 54,763
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Exhibit 4



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	06/27/2005	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			LASTRA, DANIEL	
P.O. BOX 7037			ART UNIT	
ATLANTA, GA 30357-0037			PAPER NUMBER	

3622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,103

Applicant(s)

CLARK ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-30 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

Response to Amendment

2. In response to Non Final Rejection filed 12/30/2004, the Applicant filed an Amendment on 03/30/2005, which amended claims 1, 9, 10, 14, 15, 19, 21, 22, 26, 29 and 30. Applicant's amendment overcame the Section 112 rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Ghouri (US 2002/0082978).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing at a least one product, a price of the product (see Walker paragraph 39). Walker does not expressly teach and a third-party dealer of the product. However, Ghouri teaches a system that searches for dealers of

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products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

automatically transmitting electronic signals representing at least a first option *for the user* to play a game to win the product without *the user* first making any payment (see Walker paragraph 130), *or requesting the first option* and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user *chooses* to play the game:

electronically calculating a probability of winning the product *by the user*; electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product or service (see Walker paragraph 39);

transmitting electronic signals representing dealers in the product or service and associated prices (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

automatically providing the user an option to play a game to win a selected product or service without the user first making any payment (see paragraph 130) or *requesting the option* (see paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product or service for the user (see paragraph 145).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing a plurality of different dealers and associated prices charged by each of said different dealers for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

automatically providing the user an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) *or requesting the option* (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding dealer for the user (see paragraph 145).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see paragraph 143).

P_t is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

P_m is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

P_u is probability factor that varies with the user's behavior *during a user session* (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a

Art Unit: 3622

system (see column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would

give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can *increase the probability of winning* the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

Response to Arguments

4. Applicant's arguments filed 03/30/2005 have been fully considered but they are not persuasive. The Applicant argues that Walker does not teach that a user is automatically provided with an option to play a game to win a selected product or service without requesting the option. The Examiner answers that Applicant's figure 4 teaches that a user has to click the hyperlink "win it" to play to win a product, so said user needs to make an request to play said game. Walker provisional (60/204,673) page 2, summary teaches "that the customer may be able to select one or more products (e.g., selecting on a web page, using a kiosk, scanning a barcode) that he wants to win and may try to win the product(s) through various games including slot

machine, video poker, roulette, etc...A benefit of embodiments of the present invention is that the excitement of gambling may be added to shopping, allowing the customer to win any item of the customer's choice. Adding the excitement to shopping may be able to increase sales for a particular retailer". Therefore, Walker teaches that a user makes a request to win products and therefore, teaches the Applicant's claimed invention.

The Applicant argues that Walker does not teach automatically transmitting electronic signals representing at least a first option for the user to play a game to win a product without the user first making any payment. The Examiner answers that Walker teaches in paragraph 130 "An alternate from of entry may also comprise signing one's name, providing a fingerprint, or simply asking to play the game for free. Therefore, Walker teaches at least a first option for the user to play a game to win a product without the user first making any payment.

The Applicant argues that Walker does not teach the option of purchasing of a product as an option to playing a game to win the prize. The Examiner answers that Walker teaches in paragraph 34 that "retail stores also include Websites in which descriptions and visual representations of products for sale may be viewed by customers and through which the customers may purchase one or more products for sale". Therefore, Walker gives customers the option of being directed to a merchant's website and purchase merchant's products, without the need to play a game to win said product.

The Applicant argues that Walker does not teach "probability factor that varies with the user's behavior occurring during a user session because Walker teaches that a

customer rating is associated with customer's purchasing history. The Examiner answers that Walker teaches that a customer may pay a fee in order to be associated with a particular rating (see paragraph 88). Therefore, if during a user session a customer pay a bigger fee, said customer based upon said behavior would receive a higher rating and a higher probability of receiving a winning outcome.

The Applicant argues that Walker does not teach the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system. The Examiner answers that Walker teaches in paragraph 89 that a probability may be determine based on a customer history or receiving winning outcomes stored in the customer database. Therefore, Walker teaches that the probability increase with the value derived from the user's interaction with the system.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The Right fax number of the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
May 30, 2005

Yehdega Retta
RETTA YEHEDEGA
PRIMARY EXAMINER

Exhibit 5

**WOMBLE
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& RICE**
A PROFESSIONAL LIMITED
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Fax: (404) 888-7490

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FROM	Diana Ogles	(404) 870-8177
	<small>Name</small>	<small>Direct Fax #</small>
	Number of Pages (Including Cover) 08	(404)888-7349
		<small>Direct Dial #</small>

MESSAGE:

In re application of: Clark, et al.
Serial No. 09/759,103
Filing Date: January 12, 2001
For: Search Engine Providing an Option to Win the Item Sought

Attached for filing are the following documents.

1. Notice of Appeal
2. Pre-Appeal Brief Request for Review
3. Pre-Appeal Brief

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PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P166 1010.1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450* [37 CFR 1.8(a)] on <u>September 26, 2005</u> Signature <u>[Signature]</u> Typed or printed name <u>Diana Ogles</u>		Application Number 09/759,103	Filed January 12, 2001
		First Named Inventor Clark	
		Art Unit 3622	Examiner Daniel Lastra
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>[Signature]</u> Signature John J. Timar Typed or printed name (404) 888-7412 Telephone number September 26, 2005 Date	
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/88)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 32,497			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.5. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: Daniel Lastra
Clark, et al.) Group Art Unit: 3622
Serial No: 09/759,103) Confirmation No.: 1839
Filed: January 12, 2001) Attorney Docket No.: P166 1010.1
For: Search Engine Providing an Option to Win the Item Sought

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Final Office Action mailed June 27, 2005, for the above-identified patent application, Applicants submit the following arguments in conjunction with this Pre-Appeal Request for Review.

The Examiner's rejection of claims 1, 2, 7-10, 12-15, 17-25 and 27 under 35 U.S.C. 103(a) as unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghouri, et al.* (2002/0082978) is in error.

The Examiner's ability to use either the *Walker, et al.* or the *Ghouri, et al.* published applications is predicated on the fact that both claim priority to provisional patent applications that were filed before Applicant's patent application was filed on January 12, 2001. In order to use either of these references as prior art based on earlier filed provisional applications, the provisional applications themselves must teach that which the Examiner relies upon for showing aspects of the Applicants' claimed invention in the published applications of *Walker, et al.* and *Ghouri, et al.* It is an error for the Examiner to rely on teachings of the published applications that were not also in the provisional applications from which the published applications claim priority.

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Regarding claim 10, the Examiner stated at page 3 of the office action mailed June 27, 2005 that *Walker* teaches "automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (citing *Walker*, paragraph 130) or requesting the first option and a second option to purchase the product" (citing *Walker*, paragraphs 34, 149). Applicants' arguments are found in the amendment response filed March 30, 2005 at pages 15-16. Specifically, Applicants argue that the statement in *Walker, et al.* provisional patent application 60/204,763, that the customer may be able to play for free for a limited number of plays (alternate method and use 13 on page 6 of 8) does not constitute a teaching of this particular claim step.

This isolated statement does not constitute a teaching or suggestion of an automatically transmitted option to play a game to win a product without making any payment or first requesting the option. Figs. 6, 7 and 9 in the *Walker* provisional application each show the step of receiving payment or a wager before executing the game. Fig. 8 does not explicitly show a step of payment, but the text describing the point-of-sale (POS) view depicted in this figure states at item 3 on page 8 of 8 that "If the product has been won, provide for no additional payment, otherwise credit towards payment at least some portion of the amount previously spent by the customer when trying to win the product."

Furthermore, the Examiner cannot rely on the teachings of paragraph 130 of the *Walker, et al.* published application which describes alternate forms of entry into a game since there are no counterpart teachings in the *Walker* provisional application. However, even if these teachings could be applied, the alternate forms of entry into a game to play for a product that are described in paragraph 130 are not a teaching or suggestion of automatically transmitting electronic signals representing an option to play to win a product without first requesting an option to play. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Applicants' arguments concerning the teachings of paragraph 149 are found on page 16 of Applicants' March 30, 2005 amendment response. As noted therein, *Walker* teaches that the customer pays for the product before playing a game to win the same product. In the related flowchart of Fig. 10, there is no depiction of directing a customer to a web site to buy a product. As shown in Fig. 10, the customer pays for the product, then requests to play the game to win the

product. However, even the step of requesting to play the game is not depicted in the flow charts or specification of the provisional application. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Further regarding claim 10, the Examiner stated at page 3 of the Office Action mailed June 27, 2005, that *Walker* teaches "if user chooses to purchase a product instead of playing the game: directing the user to a website which sells the product," citing *Walker* paragraphs 34, 149 - 151. Applicant's arguments are found in the Amendment response filed March 30, 2005, at pages 16 - 17. As noted therein, paragraphs 149 - 151 and Fig. 10 of *Walker, et al.* describe a process in which a customer selects a product, payment is received for the product, and the customer requests to play a game for the product.

In paragraph 150, *Walker, et al.* teaches that selection of the product is received by a POS terminal in response to a bar code scanner scanning a bar code corresponding to the product. Paragraph 151 teaches that payment for the product is received using a payment identifier associated with the customer identifier received by the customer input/output device or through manual input by the customer using the customer input/output device. As shown in Fig. 10 of *Walker, et al.*, after a customer selects and pays for the product, he then requests to play a game to either win the product or have a portion of the fee for playing the game credited to the customer. There is no teaching in *Walker, et al.* of directing the user to a website that sells a product if a user chooses to purchase a product instead of playing the game when presented with the alternative options. In Applicants' invention, the user has the selectable options to win the product or to buy the product. If the user decides to buy the product, a hyperlink takes the user to the product provider's website in order to purchase the product.

With further regard to the teachings of paragraphs 149 - 151 of *Walker, et al.*, the closest corresponding teachings are found in the provisional application in Figs. 8 - 9, the corresponding description of Fig. 9 on page 7 of 8 of the provisional application, and the description of the POS view on page 8 of 8 of the provisional application. Note that the description of Fig. 9 is "a flow chart of the exemplary method performed by the control program in an embodiment where the customer purchases the item the customer wishes to win before trying to win the item." There is no teaching in the *Walker, et al.* provisional application of the customer actually requesting an

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option to play the game. Therefore, it was an error to use the teachings of these paragraphs in the rejection of claim 10.

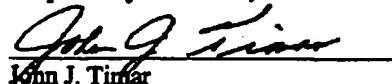
Claims 1, 15, 21 and 22 each include the limitation of automatically providing the user with an option to play the game to win a selected product or service without the user first making any payment or requesting the option. The Examiner used the same basis for rejecting these claims as he did for claim 10. As argued above, it was an error for the Examiner to apply the teachings of the *Walker, et al.* published patent application for teachings that were not found in the provisional patent application. Therefore, the rejections of claims 1, 10, 15, 21 and 22 are each based on teachings in the *Walker, et al.* published application that are not found in the provisional patent application.

Further regarding claim 1, the Examiner stated at page 4 of the Office Action mailed June 27, 2005, that *Ghowri, et al.* teaches "transmitting electronic signals representing dealers in the product or service and associated prices. The Examiner stated that *Ghowri, et al.* teaches a system that searches for dealers of products selected by users, citing paragraphs 22 and 23. Applicants' arguments concerning *Ghowri, et al.* are found at page 18 of the Amendment response filed March 30, 2005. Although Applicants' arguments were made with respect to the Examiner's rejection of claim 20, they are also applicable to claims 1, 15 and 21. *Ghowri, et al.* teaches an interactive system which provides customers with comprehensive information about a plurality of products and any associated customizable features, further providing a forum for conducting a reverse auction where sellers of products, exactly or closely matching those sought by the customer, bid for that customer's business (paragraph 22). *Ghowri, et al.* further teaches an interactive system and method for customizing an automobile through an interactive, online automobile configuration program, which may be electronically integrated and configured with dealers' inventory, and subsequently soliciting bids for the customer's automobile from a plurality of automobile dealerships over a distributed computing network (paragraph 23). As stated in paragraph 66, requests for new bids are transmitted, preferably with electronic mail, to notify the system support group and the participating dealers. Dealers can access the system of *Ghowri, et al.* and submit a bid that the customer can consider. The customer must select a bid before receiving dealer contact information (paragraph 74). Fig. 20 illustrates a sample bid results page;

Fig. 21 illustrates a bid comparison page; Fig. 22 illustrates the bid acceptance page. Only after accepting a bid does the customer obtain any dealer information. This does not represent a teaching of transmitting electronic signals representing dealers in the product or service and associated prices as claimed in claim 1. Therefore, it was an error to apply the teachings of *Ghourl, et al.* directed to a reverse auction for a customizable product in rejecting claim 1. Claims 15 and 21 both include the limitation of transmitting electronic signals representing a plurality of dealers and associated prices charged by each of the dealers. Therefore, for the same reasons as for claim 1, it was an error for the Examiner to apply the teachings of *Ghourl, et al.* in the rejection of claims 15 and 21. The Examiner has also failed to provide copies of the twelve web pages and thirty-five page technical description that are part of the *Ghourl, et al.* provisional application. Thus Applicants are unable to ascertain which teachings of the *Ghourl, et al.* published application can be applied as prior art.

In view of the above, it is submitted that the Examiner's rejection of independent claims 1, 10, 15, 21 and 22 was in error because it was based on the *Walker, et al.* published patent application filed after the present application, and relying on teachings not found in the corresponding provisional patent application and consequently not applicable as prior art. Furthermore, it was an error to apply the teachings of *Ghourl, et al.* in the rejection of Claim 1, 15 and 21, since *Ghourl, et al.* does not teach transmitting electronic signals representing dealers in the product or service and associated prices.

Respectfully submitted,



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9/26/05
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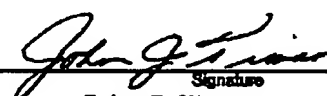
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PTO/SB/31 (04-05)

Approved for use through 07/31/2008. CMB 0651-0031

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NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) P166 1010.1
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] September 26, 2005 on _____ Signature <u></u> Typed or printed name Diana Ogles		In re Application of Clark, et al. Application Number 09/759,103 Filed 01/12/2001 For Search Engine Providing an Option to Win the Item Sought Art Unit 3622 Examiner Daniel Lastra
Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.		
The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))		\$500.00
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:		\$250.00
<input type="checkbox"/> A check in the amount of the fee is enclosed.		
<input type="checkbox"/> Payment by credit card; Form PTO-2038 is attached.		
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.		
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 09-0528 . I have enclosed a duplicate copy of this sheet.		
<input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/ZZ) is enclosed.		
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.		
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. 32,497 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		<u></u> Signature John J. Timar Typed or printed name (404) 888-7412 Telephone number September 26, 2005 Date
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.		
<input checked="" type="checkbox"/> Total of 1 forms are submitted.		

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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09/27/2005 EAREGAY1 00000074 090528 09759103

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Exhibit 6



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	12/13/2005	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			LASTRA, DANIEL	
P.O. BOX 7037			ART UNIT	
ATLANTA, GA 30357-0037			PAPER NUMBER	
			3622	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

14

Application Number 	Application/Control No. 09/759,103		Applicant(s)/Patent under Reexamination CLARK ET AL.	
	Eric W. Stamber		Art Unit 3622	
Document Code - AP.PRE.DEC				

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 9/26/05.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-30.

Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Eric W. Stamber *ES*

(3) James Myhre *JM*

(2) Daniel Lastra *DL*

(4) _____